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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,220	09/08/2003	Yoichiro Yamanaka	03547C/HG	2701
1933	7590	12/15/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			UHLIR, NIKOLAS J	
767 THIRD AVENUE			ART UNIT	
25TH FLOOR			PAPER NUMBER	
NEW YORK, NY 10017-2023			1773	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/658,220

Applicant(s)

YAMANAKA ET AL.

Examiner

Nikolas J. Uhler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This office action is in response the amendment/arguments dated 09/28/2004. Applicant amendment is sufficient to overcome the prior 35 U.S.C 112 2nd paragraph rejection. Accordingly, this rejection is withdrawn. However, the applicant's amendment has introduced new matter into the disclosure and is insufficient to overcome the previously cited prior art, as is discussed below.

#### ***Drawings***

2. The drawings dated 09/08/2003 are acknowledged and accepted by the examiner.

#### ***Specification***

3. The amendment filed 09/28/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment to pages 9, 10 and 15 of the specification changed "1:2 complex chromate and phthalocyanine" to "1:2 chromium complex and phthalocyanine." A "1:2 complex chromate" is not the same as a "1:2 chromium complex." There is no support for the terminology "1:2 chromium complex" in the disclosure as originally filed. Accordingly, the language "1:2 chromium complex" is new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 28 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case, claims 28 and 29 have been amended to substitute "1:2 chromium complex" for "1:2 complex chromate." As explained above in the section entitled "specification," a "1:2 chromium complex" is not the same as a "1:2 complex chromate." There is no support for the terminology "1:2 chromium complex" in the disclosure as originally filed. Accordingly, the language "1:2 chromium complex" is new matter. Correction is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 30 recites, "the region where the birefringence of "a" laminate layer." It is unclear whether the "a laminate layer" is "the laminate layer" on the inner surface side of the can referred to in claim 1 or if this is referring to another layer on the inner surface side. Clarification is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1-2, 4, 6-7, 9, 11, 15-16, 18, 20-25, and 30 are rejected under 35 U.S.C. 102(a) as being anticipated by Takahashi et al. (EP1174457).

10. The rejection of claims 1-2, 4, 6-7, 9, 11, 15-16, 18, and 20-25 is maintained as set forth in the prior office action.

11. Claim 30 requires the film-laminated metal sheet of claim 1, wherein the region where the birefringence of a laminate layer position on the inner surface side positioned on the surface side of the container after formation of the container is 0.02 or less and is 1 to 4 $\mu$ m from the contact interface with the metal sheet in the thickness direction.

12. The examiner interprets the language of claim 30 to merely require the region of the polyester film on the inner surface side of the can that is 1-4 $\mu$  away from the interface with the metal layer to have the required birefringence. The language of claim 30 does not prohibit the entire laminate layer on the inner surface of the can from having the required birefringence however. Bearing this in mind, the examiner takes the position that the inner side layer of Takahashi is equivalent to applicants "a laminate layer." Further, Takahashi teaches that the inner side layer has a birefringence of -.005 to -.02 (section 20). It is the examiners position that this is the birefringence throughout the entire layer. As shown in the examples of Takahashi (Table 2) the thickness of the

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film on the inner side is as high as 14-16 $\mu$ . Thus, the region from 1-4 $\mu$  away from the interface with the steel sheet will necessarily meet applicants claimed birefringence.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-7 and 15-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze et al. (JP07109363) in view of Markfort et al. (US5451304).

15. This rejection is maintained as set forth in the prior office action.

16. Claims 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markvort as set forth above for claim 1, and further in view of Iwasa et al. (JP200158585).

17. This rejection is maintained as set forth in the prior office action.

18. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markvort as applied to claim 1 above, and further in view of Iwasa (JP200158586).

19. This rejection is maintained as set forth in the prior office action.

20. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markvort as applied to claim 1 above, and further in view of Iwasa (JP200158583).

21. This rejection is maintained as set forth in the prior office action.

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22. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markvort as applied to claim 1 above, and further in view of Iwasa (JP200158588).

23. This rejection is maintained as set forth in the prior office action.

24. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markvort as applied to claim 1 above, and further in view of Iwasa (JP200158584).

25. This rejection is maintained as set forth in the prior office action.

26. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuze as modified by Markvort as applied to claim 22 above, and further in view of Tanaka (US6217994).

27. This rejection is maintained as set forth in the prior office action.

### ***Response to Arguments***

28. Applicant's arguments filed 09/28/2004 have been fully considered but they are not persuasive.

29. Applicant's first argument is directed to the previous 112 2nd paragraph rejection. This rejection has been withdrawn in view of applicant's amendment. Thus, applicant's arguments in this respect are moot.

30. Applicant's next argument is against the examiners assertion <sup>that</sup> ~~hat~~ the polarity force component  $\gamma_s^h$  of the surface free energy is taught by the cited references. With respect to Takahashi, the applicant argues that Takahashi doesn't disclose that a  $\gamma_s^h$  of  $\leq 4 \times 10^{-3}$  n/m as required by the claims. Applicants arguer that surface free energy is

divided into the polarity force component  $\gamma_s^h$  and the dispersion force (van der waals) component  $\gamma_s^d$ . Thus, applicant argues that  $\gamma_s^d$  and  $\gamma_s^h$  are independent parameters, and therefore the polarity force component  $\gamma_s^h$  cannot be derived from the surface free energy.

31. The examiner agrees with applicant's assertion insofar as a specific value of  $\gamma_s^h$  may not be able to be derived from a disclosure of total surface free energy. It is known that surface free energy  $\gamma_i = \gamma_i^{lw} + \gamma_i^{ab}$ , where  $\gamma_i^{lw}$  is the apolar component (van der waals component), and  $\gamma_i^{ab}$  is the polar component (as evidenced by "Determination of Surface Free Energies of Talc From Contact Angles Measured On Flat and Powdered Samples," available at <http://scholar.lib/vt.edu/theses/available/etd-05042001-163337/unrestricted/03chapter2.pdf>). Thus, if the surface free energy is less than applicants claimed value for  $\gamma_s^h$ , then  $\gamma_s^h$  will necessarily be within the applicants claimed range. In other words, applicant claims  $\gamma_s^h$  of  $\leq 4 \times 10^{-3}$  N/m. Takahashi discloses a surface free energy of  $2 \times 10^{-3}$  N/m. While it may not be possible for someone to derive a specific value of  $\gamma_s^h$  from the total surface free energy, as  $\gamma_i = \gamma_i^{lw} + \gamma_i^{ab}$  and  $\gamma_i^{ab} = \gamma_s^h$ ,  $\gamma_s^h$  in Takahashi must necessarily be some value below  $2 \times 10^{-3}$  N/m, and thus necessarily meets applicants claimed range.

32. Applicants argument against the other references with respect to  $\gamma_s^h$  is that they simply don't teach the claimed value or the claimed property. The examiner agrees. However, what the combination of references do teach is a polymer having a substantially similar/identical composition as that of the instant invention. The applicant is reminded that it has been held that where claimed and prior art products are identical

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or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC 102 or on *prima facie* obviousness under 35 USC 103, jointly or alternatively. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by **evidence** showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. Applicant's assertion that the combination of reference "do not teach" the claimed property, is not affirmative evidence establishing that the  $\gamma$ s<sup>h</sup> requirement is not necessarily met simply by having the same composition.

33. All of the applicant's remaining arguments depend from those addressed above, and so are unpersuasive as well.

### **Conclusion**

34. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhler whose telephone number is 571-272-1517. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**D. S. NAKARANI**  
**PRIMARY EXAMINER**